

REMARKS

Claims 1-85 are pending in the application. Claims 4, 6-13, 20, 22-29, 33, 35-42, 46, 48-55, 59, 61-68, 72, 74-81 are withdrawn from consideration. Claims 1-3, 5, 14-19, 21, 30-32, 34, 43-45, 47, 56-58, 60, 69-71, 73 and 82-85 are rejected. No claims are allowed.

Reconsideration and allowance of the claims in view of the following remarks are respectfully requested.

Claim Rejections – 35 U.S.C. § 103a. Rejection over Moriarity et al. (WO 01/47987)

Claims 1-3, 5, 14-19, 21, 30-32, 34, 43-45, 47, 56-58, 60, 69-71, 73 and 82-85 are rejected as allegedly unpatentable over Moriarity et al. (WO 01/47987; “Moriarity”) for reasons of record. According to the Examiner, the genus of the instant claims reads on the genus taught by Moriarity. Specifically, according to the Examiner, the Zx group of the instant claims includes V-R⁶ choices of Moriarity, the R^{2a} group of the instant claims includes Z choices of Moriarity, and the R^{7a} group of the instant claims includes R¹¹ choices of Moriarity. The exemplified compounds in Table 1-4 of Moriarity, according to the Examiner, provide guidance to make the genus taught therein. Applicants respectfully traverse this basis for rejection.

Applicants maintain that Moriarity provides no teaching, suggestion or incentive, either expressly or impliedly, that would have motivated one of ordinary skill in the art to modify what the reference fairly teaches to arrive at Applicants’ claimed invention. Applicants submit that any perceived overlap of the genus of the instant claims and the genus of Moriarity creates a situation analogous to the obviousness of a species when the

prior art broadly discloses a genus. See MPEP § 2144.05. This is particularly true for the chemical species recited in claim 82 of the instant application.

Regarding genus/species relationships, MPEP § 2144.05 states:

The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness. *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) (“The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.”); *In re Jones*, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992) (Federal Circuit has “decline[d] to extract from *Merck [& Co. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989)] the rule that . . . regardless of how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it.”). See also *In re Deuel*, 51 F.3d 1552, 1559, 34 USPQ2d 1210, 1215 (Fed. Cir. 1995).

MPEP § 2144.05 goes on to instruct the Examiner to make a determination of whether one of ordinary skill in the art would have been motivated to select the claimed subgenus or species by considering a) the size of the genus, b) the express teachings of the applied reference, b) any similarities in structure, properties or uses, and d) the predictability of the technology.

Here, Applicants submit that the Examiner has failed to consider any of the requisite criteria. Had the Examiner done so, a finding of nonobviousness would surely have been made. The genus of Moriarity encompasses millions of compounds, which alone indicates that the subject matter of the instant claims is nonobvious. Further, the teachings of Moriarity would lead one of skill in the art to choose compounds significantly different in structure from those of the instant claims.

For example, Moriarity teaches at pages 17-18 that preferred compounds are those where R⁹ (a substituent on R⁶) is -C(O)R¹⁰, with most preferred compounds having R¹⁰ =

NHR, which is exemplified in the species depicted in Tables 1-4 of Moriarity (preference for -C(O)NHR). In contrast, none of the substituents for Zx in the instant claims (which the Examiner equates with R⁶ of Moriarity) contains -C(O)NHR. Thus, Moriarity teaches away from the genus and species of the instant claims, including the particular chemical species recited in claim 82. See *Baird*, 16 F.3d at 382-83 (reversing obviousness rejection of species in view of large size of genus and disclosed “optimum” species which differed greatly from and were more complex than the claimed species); *Jones*, 958 F.2d at 350 (reversing obviousness rejection of novel dicamba salt with acyclic structure over broad prior art genus encompassing claimed salt, where disclosed examples of genus were dissimilar in structure, lacking an ether linkage or being cyclic).

Accordingly, Applicants submit that claims 1-3, 5, 14-19, 21, 30-32, 34, 43-45, 47, 56-58, 60, 69-71, 73 and 82-85 are not *prima facie* obvious over Moriarity, and reconsideration of this basis for rejection is respectfully requested.

b. Rejection over Erickson et al. (WO 01/47921)

Claims 1-3, 5, 14-19, 21, 30-32, 34, 43-45, 47, 56-58, 60, 69-71, 73 and 82-85 are rejected as allegedly unpatentable over Erickson et al. (WO 01/47921; “Erickson”) for reasons of record. According to the Examiner, the genus of the instant claims includes compounds of the genus of Erickson. Specifically, according to the Examiner, the Zx group of the instant claims includes R³R⁴ (wherein R³ is H and R⁴ is OR¹⁸, R¹⁸ being a hydrocarbon or heteroaryl) choices of Erickson, the R^{2a} group of the instant claims includes R-N-Y choices of Erickson, and the R^{7a} group of the instant claims includes R² (wherein R²=R⁷-R⁶-N-R⁵) choices of Erickson. The exemplified 164 compounds in

Table 1 of Erickson, according to the Examiner, provide guidance to make the genus taught therein. Applicants respectfully traverse this basis for rejection.

Applicants maintain that the genus of the instant claims does not include compounds of the genus of Erickson. When, as the Examiner notes, R^3 is a direct bond and R^4 of Erickson is OR^{18} , R^{18} must be a hydrocarbon or heteroaryl. In contrast, Zx of the instant claims (which the Examiner equates with R^3R^4 of Erickson) contains substituted aryl or cycloalkyl—none of the substituents shown is a hydrocarbon or heteroaryl. Thus, contrary to the Examiner's position, there is no overlap between the genus of Erickson and the genus of the instant claims.

Moreover, as with Moriarity discussed above, Erickson teaches away from the genus and species of the instant claims. Like Moriarity, the genus of Erickson encompasses millions of compounds. From this extremely large genus, Erickson teaches at pages 7-11 that when R_3 is a direct bond, preferred compounds do not include $R^4 = OR^{18}$ (even assuming R^{18} includes substituted aryl or cycloalkyl, which it does not). Rather, R^4 is selected from substituents not included in Zx of the instant claims, as reflected in the species depicted in Table 1 of Erickson. Thus, Erickson teaches away from the genus and species of the instant claims, including the particular chemical species recited in claim 82. *See Baird*, 16 F.3d at 382-83; *Jones*, 958 F.2d at 350.

Accordingly, Applicants submit that claims 1-3, 5, 14-19, 21, 30-32, 34, 43-45, 47, 56-58, 60, 69-71, 73 and 82-85 are not *prima facie* obvious over Erickson, and reconsideration of this basis for rejection is respectfully requested.

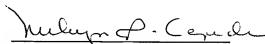
CONCLUSION

It is believed that claims 1-3, 5, 14-19, 21, 30-32, 34, 43-45, 47, 56-58, 60, 69-71, 73 and 82-85 are now in condition for allowance, early notice of which would be

appreciated. If any outstanding issues remain, the Examiner is invited to telephone the undersigned at the number indicated below to discuss the same.

Respectfully submitted,

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